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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91186473
Party	Plaintiff Apex, LLC
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Submission	Opposition/Response to Motion
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Date	03/20/2009
Attachments	Opposition Brief to Pavers' Motion to Compel 3.20.09.pdf (7 pages)(26392 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

APEX, LLC	:	
	:	
Opposer,	:	Opposition No. 91186473
v.	:	Serial No. 77/243,433
	:	Mark: APEX PAVERS (and design)
APEX PAVERS, INC	:	Filing Date: July 31, 2007
Applicant	:	

**OPPOSER’S BRIEF IN SUPPORT OF ITS OPPOSITION
TO APPLICANT’S MOTION TO COMPEL**

I. INTRODUCTION

The Board should deny Applicant’s Motion to Compel. It was filed prematurely and it has been mooted by Opposer’s supplemental discovery responses. In short, it is a perfect example of a discovery dispute that easily could have been avoided if Applicant’s counsel had simply worked cooperatively with opposing counsel to resolve some scheduling difficulties Opposer was facing as a result of the hiring of new in-house counsel.

Because Applicant’s counsel refused to grant Opposer *any* extension of time to respond to its discovery requests, Opposer was forced to serve responses that were incomplete. And now, having created this discovery problem by behaving unreasonably, Applicant wants to complain to the Board that Opposer is violating its discovery obligations. The accusation is false and unfair.

II. FACTS

A. The Opposition Proceeding

1. Opposer, Apex, LLC, is the owner of a family of federally registered and common law Apex marks (and pyramid designs) that are used in connection with a variety of goods and services, including retail for, among other things, home and garden goods (including outdoor

products related to pools, patios, and backyards) and for real estate construction, management and development services (including remodeling and design). Opposer, through its predecessors and their affiliates (“Apex”) has made use of its APEX Marks since the 1920s. A number of Opposer’s federally registered marks are incontestable.

2. Applicant filed an application on July 31, 2007 to federally register “Apex Pavers” with a pyramid design.

3. According to the application, Applicant uses its Apex Pavers Mark in connection with the construction of swimming pools; paving contractor services; installation of driveways, patios, walkways, pool decks, remodeled pools, walls, and spa additions.

4. Because Opposer for many years has been in the business of providing goods and services in related fields and has used its Apex Marks in connection with those goods and services, it filed an opposition to Applicant’s application.

B. Applicant’s Discovery Requests

5. On January 5, 2009, Applicant served Opposer with a first request for admissions, a first set of interrogatories, and a first request for production. (Two days earlier, Applicant had filed and served a Motion to Amend its application.)

6. On January 23, 2009, on her first day of work, Opposer’s new in-house trademark counsel, Gwenn Roos, Esq., contacted Applicant’s counsel and requested an extension of time to respond to Applicant’s discovery requests (and the Motion to Amend). Attorney Roos explained that she had just joined the company and that the employee she needed to assist her in preparing responses was travelling for two weeks.

7. Applicant's counsel refused to consent to the extension and did not propose any alternative -- a shorter extension for example. The reasons for this uncooperative behavior are unclear.

8. Because of Applicant's intransigence, On February 10, 2009, Opposer was forced to serve its responses (admittedly incomplete in some instances due to the timeframe imposed) to the interrogatories and document requests. Despite the burden of the timeframe, Opposer also provided responses to the request for admissions.

9. On February 20, 2009, Applicant's counsel wrote to Opposer and complained about the incomplete discovery answers and the objections interposed by counsel. Applicant had steadfastly refused to grant any extension to Opposer and the letter failed to offer a suggestion for a resolution. This, apparently, is what Applicant's counsel is relying upon when she states in her Brief that she made a "good faith" attempt to resolve the discovery dispute.

10. The February 20, 2009 letter does not acknowledge that the unwillingness to grant Opposer any extension was the exclusive reason for the so-called discovery dispute. The letter also contains a number of allegations with which Opposer disagrees.

11. On February 26, 2009, the undersigned attorney, Brent Canning, contacted Applicant's counsel on behalf of Opposer in an attempt to address and resolve Applicant's concerns. Opposer's counsel explained that he was just joining Opposer and requested another week or so to review the supplemental discovery responses that Applicant was preparing. He committed to getting Applicant's counsel supplemental responses.

12. The following day, for reasons that are unclear, Applicant's counsel once again refused to extend any courtesy to opposing counsel. And once again, Applicant's counsel offered

no compromise position – despite stating in her February 20, 2009 letter that she was interested in working toward a reasonable resolution.

13. At no time did Applicant's counsel articulate any reason why she was unable to behave more cooperatively. She did not identify any emergent circumstances and Opposer's counsel are unaware of any.

15. Nevertheless, the next week, on March 6, Applicant filed the instance Motion to Compel. The Motion does not acknowledge how Applicant's uncooperative behavior has created this so-called dispute.

16. On March 15, 2009, Opposer served supplemental discovery responses to Applicant's first set of interrogatories and first request for production by electronic mail and overnight delivery. (The supplemental discovery responses are attached as Exhibits A and B.) In addition, Opposer provided Applicant with copies of responsive documents showing Opposer's use of its Apex Marks in connection with its retail (home, patio and garden, among other things) and real estate services.

17. Opposer's counsel also sent Applicant's counsel a cover letter and specifically asked to speak with Applicant's counsel to resolve the dispute without involving the Board. (The cover letter is attached as Exhibit C.)

18. Applicant's counsel ignored the request.

19. Opposer's counsel telephoned Applicant's counsel's office on the afternoon of March 20, 2009 but was informed that she was not available.

III. ARGUMENT

Opposer respectfully requests that Applicant's Motion be denied as premature (because it was filed without negotiating with opposing counsel in good faith) and moot (because Applicant

has supplemented its discovery responses and stands ready to address any outstanding discovery concerns).

The arguments advanced in Applicant's brief are largely beside the point. For instance, Applicant spends pages advocating the unremarkable proposition that Applicant is entitled to conduct discovery. No one is claiming otherwise. What Opposer is claiming is that it needed a reasonable period of time to properly respond to Applicant's discovery requests. For whatever reason, Applicant and its counsel have been unwilling to consent to *any* extensions. It is that uncooperative behavior that resulted in the initial discovery responses that led Applicant's counsel to file this Motion. The Motion is now moot as Opposer's counsel has now provided Supplemental Responses.

Applicant also asks the Board to treat any of Opposer's objections as waived because the initial discovery responses were served one day late. Given that Opposer's counsel specifically explained that it could not provide substantive responses in the time demanded by Applicant's counsel, the argument seems churlish. Opposer was faced with unreasonable counsel who would not consent to any extension and so it provided what information it could and interposed its objections to preserve them until it could provide more substantive responses. In addition, as set forth in Opposer's counsel's January 10, 2009 cover letter (attached as Exhibit D to Applicant's Brief), the responses were served one day late because of a computer error incurred by Opposer's outside counsel.

Ultimately, this discovery dispute has been mooted because Opposer has, in fact, supplemented its discovery responses with substantive answers and it has provided responsive documents to Applicant. Opposer believes that the supplemental responses resolve Applicant's

concerns and, to the extent any remain, Opposer is ready to discuss those concerns in good faith and provide further supplementation if appropriate.

IV. CONCLUSION

For the foregoing reasons, Applicant's Motion should be denied.

Respectfully Submitted,

APEX, LLC

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Dated: March 20, 2008

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing Opposition Brief is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on March 20, 2009.

/Brent R. Canning/
Brent R. Canning

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposition Brief is being deposited with the U.S. Postal Service with sufficient postage as first class mail March 20, 2009 in an envelope addressed to Applicant's attorney of record at the following address:

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